

## REMARKS

### I. Claim Objections

Claims 30-52 stand objected to under 37 CFR 1.75 (g) and MPEP 608.01(e) because the independent claims should be presented in order, with the least restrictive claims to be presented as claim number 1” To the extent the objection is maintained, and as best understood by Applicant respectfully traverses the objection.

Initially, Applicant notes that the above rule is a “suggestive” rule which pertains primarily for a newly filed application. It is not a mandatory rule as indicated by the term “should” (mandatory rules typically use the term “must” or “shall”). Hence, such rule is not a basis upon which an objection can be made to compel action from Applicant. Further, another mandatory rule prohibits renumbering of claims (37 CFR 1.126). Finally, as the Examiner has already examined the claims, any benefit of reordering the claims would seem less productive and less beneficial at such point. The desired correction by the Examiner would seemingly either compel Applicant to violate a mandatory rule, or make the file history less coherent. Accordingly, to the extent that the objection is maintained in lieu of Applicant’s amendments, Applicant respectfully request withdrawal thereof.

The Examiner maintains the rejection simply stating “[t]he Examiner disagrees and notes it is only an Objection therefore the objection is maintained.”

Applicant respectfully traverses the continued objection. The Examiner provides no basis for maintaining the objection in lieu of Applicant’s traversal thereof. The objection appears to be arbitrary and capricious. Accordingly, Applicant respectfully request withdrawal thereof.

**II. 112 ¶ 1 Rejection**

Claims 30-52 stand rejected under 35 U.S.C. § 112 ¶ 1 for allegedly containing subject matter “which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.” The Office action directs Applicant’s attention to the limitation “wherein the first chip package, the second chip package and the interchip content pathway are contained in a single device without an interface between eachother”. Applicant respectfully traverses the rejection.

Of skill in the art can readily ascertain that the inventors had possession of such at the time of filing. As acknowledged by the Office action, the specification must reasonably convey to those skilled in the art that the application was in possession of the claimed invention as of the date of the invention. See, MPEP 2106, V. B. 1., citing, *Hyatt v. Boone*, 146 F.3d 1348, 1354, 47 USPQ2d 1128, 1132 (Fed. Cir. 1998). There is no requirement for an *ipsis verbis* descriptions.

Applicant’s Figures clearly illustrate a plurality of chip packages, e.g. with reference to Fig. 1A, 126, 130 and an interchip content pathway e.g. 150 in a single device 104-1. Interfaces 134 and 138 are also clearly illustrated, and such are not located between a first and second chip package. See also Applicant’s specification at least, ¶s 8-14, in which chip packages, data links and interfaces are discussed. One of skill in the art would clearly determine that Applicant had possession of the above limitation at the time of filing Applicant’s specification.

**III. 112 ¶ 2 Rejection**

Claims 30-52 stand rejected under 35 U.S.C. § 112 ¶ 2 for allegedly being unclear.

First, the Office action asserts that “it is not clear what the Applicant is defining as a ‘single device’”. Applicant respectfully traverse. A claim is considered indefinite if it does not reasonably apprise those skilled in the art of its scope. *IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377, 1383-84 (Fed. Cir. 2006); *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1217 (Fed. Cir. 1991). Applicant respectfully submits that “a single device” as used in the claim phrase “wherein the first chip package, the second chip package and the interchip content pathway are contained in a single device” is not ambiguous, does not lack clarity, and is not indefinite. It is well known a device may hold multiple components or multiple other devices, e.g. an automobile may hold of thousands of components and other devices.

The Office action also asserts that “[i]f there is not an (sic) interface between the first and second chip packages how is ‘ciphertext content received from the first chip package’”. To the extent the comment constitutes a rejection, it is traversed. As clearly set forth in the claims interchip content pathways provide communications between the first chip package and the second chip package “carrying the ciphertext content from the first chip package to the second chip package”. Accordingly, the rejection is not understood. Moreover, the Examiner is respectfully reminded that definiteness and interpretation of terms in the claims is from the perspective of one of skill in the art. Those of skill in the art clearly appreciate interchip content pathways and interfaces.

#### **IV. Prior Art Rejections**

Claims 30-52 stand rejected under 35 U.S.C. § 103 as being unpatentable over Coli (5,452,355) in view of Candelor (6,697,489) in view of Maruo et al. (7,146,007).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *KSR Intl. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742, 82 USPQ2d 1385, 1397 (S.Ct. 2007); *Ecolochem Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 56 U.S.P.Q.2d (BNA) 1065 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2D (BNA) 1614, 1617 (Fed. Cir. 1999); *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992); and *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). See also MPEP 2143.01.

A probative inquiry in determining obviousness under 35 USC § 103(a) as to the present invention is whether the inventors achieved the invention by doing what those skilled in the art suggested should not be done. See, *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). "The degree of teaching away will of course depend on the particular facts; in general, a reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant." See *United States v. Adams*, 383 U.S. 39, 52, 148 USPQ 479, 484 (1966). A reference teaches away if it would discourage the art worker from attempting the substitution undertaken by the present inventors. *Gillette Co. v. S.C. Johnson & Son, Inc.*, 919 F.2d 720, 724-25, 16 USPQ2d 1923 (Fed. Cir. 1990). A reference teaches away if it suggest the combination would produce a "seemingly inoperative device." *In re Sponnoble*, 405 F.2d 578, 160 USPQ 237, 244 (CCPA 1969). Accordingly, the suggested combination is improper and should be withdrawn.

Neither Coli nor Candelore `489, taken alone or in combination disclose or suggest the claimed invention recited by the above amended claims. Neither Coli nor Candelor `489 appear

to be related to interchip data protection. Coli merely discloses an approach for creating fuseable links on the IC level to encode data in an IC. Coli does not protect interchip communications. At best, Coli provides for a non-readable and non-rewritable IC.

As explained in Applicant's previous response, Candelor '489 is also not concerned with interchip content protection. Candelor '489 uses a smart card (410) to control words, which are then sent to a second device (401) under encryption through an interface 420. See, Figs. 2 and 6. The control words are decrypted by the second device and used to descramble content (480) at descrambler 470 and provided as "descrambled transport stream 490". See, Fig. 2. The content is not received by the smart card 410 and is not encrypted by the smart card 410. Further, the content is not encrypted on an interchip content pathway in either the smart card 410 or the second device 401, which merely provides descrambling of content which may have been scrambled by the content provider.

Maruo also does not protect interchip communications. Maruo evens explicitly teaches away from the invention by teaching to eliminate the interchip communications. Specifically, Maruo integrates the security chip and the decoding chip in order to eliminate communications between these chips. See, Fig. 3 and abs.

Accordingly, the combination of Coli, Candelor and Maruo does not produce the claimed invention and do not render the claims unpatentable. Moreover, Maruo clearly teaches away from producing the claimed invention, and hence the rejection is improper.

In response to previously submitted arguments, the Examiner asserts "[F]irst and IC is a chip. Second if an IC is non-readable or non-rewritable the interchip communications are protected." See, Office Action, mailed December 17, 2010, pg. 3. In further responding to previously submitted arguments against Candelor '489, the Examiner asserts "[s]ince the content

within a smartcard is protected Candelor does protect ‘interchip content pathways’.” See, Office Action, mailed December 17, 2010, pg. 3. However, protection of data on a chip or within a chip (aka intrachip) does not protect the data when its communicated outside of that chip to another chip, *i.e.* between chips - aka interchip communications.<sup>1</sup> None of the prior art, including newly cited Maruo, provide a mechanism for protecting interchip communications. Clearly, neither Coli nor Candelor ‘489 disclose such. Rather than protecting interchip communications, the approach in Maruo is to eliminate such interchip communications, making them intrachip communications.

Accordingly, Applicant respectfully request allowance of the above claims.

## **V. Conclusion**

Having fully responded to the Office action, the application is believed to be in condition for allowance. Should any issues arise that prevent early allowance of the above application, the examiner is invited contact the undersigned to resolve such issues.

To the extent an extension of time is needed for consideration of this response, Applicant hereby request such extension and, the Commissioner is hereby authorized to charge deposit account number 505278 for any fees associated therewith.

Respectfully submitted,

June 17, 2011

By: /Larry T. Cullen/  
Larry T. Cullen  
Reg. No.: 44,489

Motorola Connected Home Solutions  
101 Tournament Drive  
Horsham, PA 19044  
(215) 323-1797

---

<sup>1</sup> The prefix “inter” means “between or among”. See Webster’s II New Riverside Dictionary Revised Edition, 1996.